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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,318	10/17/2001	D. Wade Walke	LEX-0255-USA	4962

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LEXICON GENETICS INCORPORATED  
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THE WOODLANDS, TX 77381-1160

EXAMINER

GUCKER, STEPHEN

ART UNIT PAPER NUMBER

1647

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/981,318

Applicant(s)

WALKE ET AL.

Examiner

Stephen Gucker

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4 drawn to isolated nucleic acids and vectors, classified in class 536, subclass 23.1.
  - II. Claim 5, drawn to an isolated protein, classified in class 530, subclass 350.

The inventions are distinct, each from the other because of the following reasons:

- a. Although there are no provisions under the section for "Relationship of inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Groups I and II are directed to products that are distinct both physically and functionally, are not required one for the other, and are therefore patentably distinct. Further, the DNA of Group I can be used to make proteins and in other assays such as gene therapy or as a probe in hybridization assays. The proteins of Group II can be isolated from different sources, such as native cell lines or peptide syntheses.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification,

separate search requirements and divergent subject matter, restriction for examination purposes as indicated is proper.

2. Restriction to one of the following inventions is also required under 35 U.S.C. 121:

Groups 1-18. The inventions as they pertain to each of SEQ ID NOS: 1, 3, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27 29, 31, 33 and/or 35 classification dependent upon the nature of the inventions. For example, if Applicant elects Group 3, the invention will be examined to the extent that it reads on SEQ ID NO: 5.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, separate search requirements and divergent subject matter, restriction for examination purposes as indicated is proper.

The inventions are distinct, each from the other because of the following reasons:

- b. Although there are no provisions under the section for "Relationship of inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Each of the sequences in Groups: 1-18 is a unique nucleic acid sequence, requiring a unique search of the prior art. Searching all of the above sequences in a single patent application would provide an undue search burden on the examiner and

the USPTO's resources because of the non-coextensive nature of these searches.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art shown by their separate search requirements, restriction for examination purposes as indicated is proper.

3. Restriction to one of the following inventions is also required under 35 U.S.C. 121:

Group 19-35. The inventions as they pertain to each SEQ ID NOS: 2, 4, 6, 8, 10, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, and 34. For example, if Applicant elects Group 20, the invention will be examined to the extent that it reads on SEQ ID NO: 4.

The inventions are distinct, each from the other because of the following reasons:

- c. Although there are no provisions under the section for "Relationship of inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper because these products constitute patentably distinct inventions for the following reasons. Each of the sequences in Groups: 19-35 is a unique amino acid sequence, requiring a unique search of the prior art. Searching all of the above sequences in a single patent application would provide an undue search burden on the examiner and

the USPTO's resources because of the non-coextensive nature of these searches.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art shown by their separate search requirements, restriction for examination purposes as indicated is proper.

**In order to be fully responsive, Applicant must select one from Group I-II, one from Group 1-18, and one from Group 19-35. Applicant is advised that neither I-II, 1-18, nor 19-35 are species election requirements; rather each of I-II, 1-18 and 19-35 is a restriction requirement.**

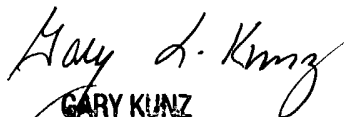
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (571) 272-0883. The examiner can normally be reached on Monday through Friday, 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GC  
Art Unit 1646  
28 June 2004

  
**GARY KUNZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**